

REMARKS

After entry of the instant Amendment, claims 4, 5, and 8-25 are pending in the application. Claims 13-17 and 19-23 stand withdrawn as non-elected claims that were subject to a restriction requirement. Claims 4 and 5 are currently amended. Claims 24-28 are new. Claims 1-3, 6, and 7 were previously cancelled.

To explain the amendments to the claims, independent claims 4 has been amended to further define the organosilicon compound (B) as selected from the group of organopolysiloxane resins and linear organopolysiloxanes, which are two classes of organopolysiloxanes set forth in paragraph [0031] on page 10 of the original application as being suitable for component (B), with numerous specific examples provided. Independent claim 5 has been amended to further describe certain features of the organopolysiloxane resin (A) relative to molecular weight and viscosity thereof. Support for these amendments relative to the organopolysiloxane resin (A) can at least be found in paragraph [0026] on page 9 of the original application. Independent claim 5 has also been amended to further define (d2) as an organosiloxane oligomer, with additional features of the oligomer also added to independent claim 5. Support for the amendments to independent claim 5 relative to (d2) can at least be found in paragraph [0041] on page 12 of the original application.

To explain the new claims that have been added, new dependent claims 24 and 25 further define the organopolysiloxane resin (A) as methylvinylphenylpolysiloxane resin (with claims 24 and 25 depending from independent claims 4 and 5, respectfully), support for which can at least be found in paragraphs [0075]-[0077] in which specific examples of

suitable organopolysiloxane resins (A) are described as methylvinylphenylpolysiloxane resins. New dependent claims 24 and 25 also further specifies the organosilicon compound (B) as being selected from the group of methylphenylhydrogenpolysiloxane resin and linear methylphenylhydrogenpolysiloxane, support for which can at least be found in paragraphs [0078] and [0079] on page 21 of the original application in which specific examples of suitable organosilicon compounds (B) are described. New dependent claim 25 also further defines the organosiloxane oligomer (d2) of claim 5 a methylvinylphenylsiloxane oligomer, support for which can at least be found in paragraph [0080] on page 21 of the original application, which describes a specific example of a suitable organosiloxane oligomer (d2). The Applicants respectfully submit that no new matter is added through the instant Amendment.

With regard to the withdrawn claims 13-17 and 19-23, the Applicants respectfully maintain that, because claims 13-17 and 19-23 are process claims which require all the elements of the previously-elected product claims (i.e., claims 4, 5, 8-12 and 18), the Applicants are entitled to rejoinder of these claims upon allowance of the product claims.

Claims 4, 5, 8-12, and 18 stand finally rejected under 35 USC §103(a) as being unpatentable over Kushibiki et al. (European App. No. 0682271) in view of Amano et al. (USPN 5672672). As set forth in further detail below, the Applicants respectfully submit that the amendments to independent claims 4 and 5 serve to overcome the rejections of these claims under 35 USC §103(a) over Kushibiki et al. in view of Amano et al. such that these rejections must be withdrawn. The Applicants further submit that the Examiner cannot

properly establish new rejections of claims 4 and 5 (as well as the claims that depend therefrom) under 35 USC §103(a) over Kushibiki et al. in view of Amano et al., or further in view of any additional references.

Despite the amendments to independent claims 4 and 5, the Applicants are unwilling to concede that the Examiner has properly established a *prima facie* case of obviousness of independent claims 4 and 5, prior to the instant amendments, over Kushibiki et al. in view of Amano et al. Nevertheless, the Applicants have chosen to amend the instant independent claims 4 and 5 in a manner that definitively distinguishes the instantly claimed hydrosilation-cured product in claims 4 and 5 from the compositions of Kushibiki et al. such that the rejections over Kushibiki et al. in view of Amano et al. are overcome. In particular, the Applicants respectfully submit that, even assuming proper combination of the teachings of Kushibiki et al. and Amano et al., each and every feature of independent claims 4 and 5 cannot be accounted for in Kushibiki et al. and Amano et al. such that a *prima facie* case of obviousness cannot be established based upon the combination of these references.

The Applicants respectfully submit that it remains a fundamental tenet of the obviousness analysis that reference(s) relied upon to establish an obviousness rejection must teach or suggest each and every feature of a claim. In particular, MPEP § 2143.03 requires the "consideration" of all words in a claim in an obviousness determination. However, to render a claim unpatentable, the Examiner must do more than merely "consider" each and every feature of the claim. In particular, the asserted reference(s) must also teach or suggest each and every claim feature. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)

(to establish prima facie obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." See *Ex parte Wada and Murphy*, Appeal 2007-3733, (citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)) (emphasis in original). This is supplemented by MPEP §904, which states that the Examiner's search "should cover the invention as described and claimed." These principles remain unchanged by the decision in *KSR Int'l Co. v. Teleflex Inc.*

Given the fact that each and every element in independent claims 4 and 5 must be accounted for to properly reject these claims under 35 USC §103(a) over Kushibiki et al. and Amano et al., the Applicants respectfully submit that this burden cannot be met by the Examiner because these references fail to teach at least component (B) (for purposes of both independent claims 4 and 5) and component (d2) (for purposes of independent claim 5). To explain, component (B) in independent claims 4 and 5 is now further specified to be selected from the group of organopolysiloxane resins and linear organopolysiloxanes, which organopolysiloxanes having two or more silicon-bonded hydrogen atoms per molecule. Relative to the teachings of Kushibiki et al. and Amano et al. with regard to component (B) as claimed, the Examiner has relied solely upon Kushibiki et al. to find the reactants used to make the hydrosilation-cured reaction product in claims 4 and 5. While Kushibiki et al. does teach a hydrosilation-curable composition, Kushibiki et al. only teaches phenyltris(dimethylsiloxy)silane as a suitable compound having an SiH group. Notably, the

phenyltris(dimethylsiloxy)silane is **not** an organopolysiloxane, and Kushibiki et al. contains no teachings of organopolysiloxanes that contain SiH groups. As such, neither Kushibiki et al. nor Amano et al. teach component (B) of independent claims 4 and 5.

With regard to component (d2) in independent claim 5, again, the Examiner has relied solely upon Kushibiki et al. to find the reactants used to make the hydrosilation-cured reaction product in claim 5, including component (d2). The Examiner has used the teachings in Kushibiki et al. of $\text{ViMe}_2\text{SiO}_{1/2}$ in the Reference Example to find the previously claimed diluent (d2) within the teachings of Kushibiki et al. However, given the amendments to independent claim 5 that further specify the component (d2), the Applicants respectfully submit that the disclosure of $\text{ViMe}_2\text{SiO}_{1/2}$ in Kushibiki et al. can no longer be interpreted against component (d2) in any way, and Kushibiki et al. contains no other teachings of that can be interpreted against the instantly claimed component (d2) in independent claim 5.

In addition to the fact that the combined teachings of Kushibiki et al. and Amano et al. fail to teach each element of independent claims 4 and 5 as amended, the Applicants further submit that the Examiner cannot establish obviousness of independent claims 4 and 5 based upon the combined teachings of Kushibiki et al. and Amano et al., alone or in combination with other references. As set forth in the final Office Action, the Examiner has used Amano et al. primarily as a general reference to show that it was known to use polysiloxane compositions in the field of waveguides by altering their refractive indexes for core-clad arrangement, with reliance on Kushibiki et al. for teachings of the specific

composition claimed in independent claims 4 and 5. The Applicants are unwilling to concede that the general teachings of Amano et al. provide sufficient guidance to one of skill in the art that the compositions of Kushibiki et al. can be successfully modified to make waveguides, given uncertainty with regard to whether the compositions of Kushibiki et al. would possess sufficient resistance to intermixing so as to acceptably make the waveguides. After all, without any guidance whatsoever in Kushibiki et al. that the compositions taught therein have sufficient resistance to intermixing, one of skill in the art would have no more of a reason to choose the compositions of Kushibiki et al. for the purpose of making waveguides than to choose from any of the countless known polysiloxane compositions that are known for optical applications.

While the Examiner has focused on benefits with regard to mechanical strength (a benefit of the composition taught by Kushibiki et al.) as providing sufficient reason for one of skill in the art to use the compositions of Kushibiki et al. for the waveguides as taught by Amano et al., mechanical considerations would clearly play a cursory role in the decision by a person of skill in the art when choosing a composition with which to make a waveguide. The clear focus would be on resistance to intermixing and other properties of the composition that will affect optical properties of the waveguide.

The Examiner's equation between the cross-linking mechanisms taught in Amano et al. and Kushibiki et al., which rely on a urethane bond-forming reaction between an isocyanate group and a hydroxyl group, is duly noted. However, compositions that are cross-linked through urethane bond-forming reactions are distinct from other compositions

described in Kushibiki et al. that rely on hydrosilation cross-linking mechanisms such that no inferences can be rightly made as to whether the compositions cured through hydrosilation cross-linking mechanisms in Kushibiki et al. would possess suitable properties for purposes of making the waveguides of Amano et al. The Applicants respectfully maintain that such facts render the Examiner's attempt to establish *prima facie* obviousness of the instantly claimed invention insufficient, even with the current state of the standards for determining obviousness of an invention.

In view of the foregoing, the Applicants respectfully submit that the amendments to independent claims 4 and 5 serve to overcome the rejections of these claims under 35 USC §103(a) over Kushibiki et al. in view of Amano et al. Further, the Applicants respectfully submit that the Examiner cannot properly establish new rejections under 35 USC §103(a) of claims 4 and 5 as amended by relying upon the combined teachings of Kushibiki et al. and Amano et al., alone or in combination with other references. As such, the Applicants respectfully submit that independent claims 4 and 5, as well as the claims that depend therefrom, are in condition for allowance, which allowance is respectfully requested.

The appropriate fee for a Request for Continued Examination is included herewith, and it is believed that no further fees are presently due including for the new dependent claims.

In particular, 20 claims are pending after entry of the instant Amendment. However, the Commissioner is authorized to charge Deposit Account No. 08-2789 for any fees or to credit the account for any overpayment.

Respectfully submitted,

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